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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,001	11/29/2001	Jack D. Taylor	KCX-387 (15828)	3912
22827	7590	07/02/2004	EXAMINER	
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			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/998,001

Applicant(s)

TAYLOR, JACK D.

Examiner

Hal Vo

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8, 10-19, 41-46, 58 and 59.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 5. does NOT place the application in condition for allowance because: It is noted that the art rejections over Ying are withdrawn in view of the present arguments since Ying does not teach a thermoplastic polyurethane elastomer film containing a filler. However, the art rejections over Kaneko are maintained for the following reasons. Applicant argues that the "consisting essentially of" limits the scope of a claim to the specific materials that do not materially affect the basic or novel characteristics of the invention to be derived from a thermoplastic polyurethane elastomer and a filler. The inclusion of an ethylene-alpha-olefin copolymer in an amount suggested by Kaneko substantially changes the basic or novel characteristics of Applicant's present invention. However, nothing in the specification discloses or suggests the presence of the ethylene-alpha-olefin copolymer affects the novel or basic characteristics of Applicant's present invention. The mere absence of the ethylene-alpha-olefin copolymer in the specification is not basis for exclusion. Therefore, Applicant bears the burden in establishing that non-recited components materially change the characteristics of Applicants' invention (MPEP 2112; In re Delajarte 143 USPQ 256) in order to overcome anticipation or the finding of obviousness. Accordingly, the language "consisting essentially of" is treated as "comprising" until Applicants provide the evidence in establishing that non-recited components materially change the characteristics of Applicants' invention. Further, Applicant states that Kaneko does not disclose or suggest forming the film from only a thermoplastic polyurethane elastomer as the film forming material with respect to claim 14. However, the "comprising" does not exclude an embodiment wherein an elastic film includes a second elastic polymer film material. Accordingly, the elastic film of claim 14 does not exclude the ethylene-alpha-olefin copolymer as argued by Applicant. Therefore, the art rejections over Kaneko are sustained.



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